

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Justin Charles Moodie, *et al.*
Serial No.: 09/848,262
Filed: May 4, 2001
For: SCHEMES EMPLOYING MOBILE COMMUNICATIONS
Group: 3622
Examiner: Raquel Alvarez

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

Sir:

Appellant submits this Reply Brief in the above-referenced application. The Examiner's Answer was mailed on October 29, 2007. Any fees associated with this matter are authorized to be charged to Deposit Account 11-0600.

STATUS OF CLAIMS

Claims 1-58 are pending in this application, and claims 18-27 and 37-58 have been withdrawn pursuant to a restriction requirement. Claims 1-17 and 28-36 stand finally rejected, as stated in the final Office Action dated November 16, 2006, and are the subject of this appeal.

STATUS OF AMENDMENTS

Appellants have filed no amendments subsequent to the mailing of the final Office Action dated November 16, 2006.

GROUND OF REJECTION TO BE REVIEWED

The final Office Action rejects claims 1-17 and 28-36 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,729,693 to *Holda-Fleck* ("*Holda-Fleck*").

ARGUMENT

Appellants assert that the preamble to claims 1, 14-17, and 28 should be given patentable weight and that the Official Notice taken on page 4 of the Final Office Action should be withdrawn. In addition, Appellants refer to Appellants' argument set forth in the Appeal Brief filed October 3, 2007.

The Examiner asserts that the preamble of claims 1 and 14-17 should not be given any patentable weight. (Examiner's Answer, page 5, citing *In re Hirao* 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951)). Appellants disagree. The preambles of claims 1, 14, 15, 16, and 17 state:

"In a reward scheme in which users accumulate points in respective user accounts, which points are redeemable for rewards, a method comprising:."

Contrary to the Examiner's position, the preamble of claims 1 and 14-17 breath life and meaning into the claims. Consider the steps of claim 1,

- a) receiving a voucher carrying a voucher code;
- b) inputting the voucher code to a mobile terminal; and
- c) transmitting the voucher code from the mobile terminal over a wireless network to a predetermined network address.

Read without the context of the preamble, it may not be clear who or what the actor is in these steps. But, read in the context of the preamble it is clear that the actors for steps a and b are "users accumulat[e](ing) points in respective user accounts." (Preamble, Claim 1). (See M.P.E.P. 2111.02 I. "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." Citing *Corning Glass Works v. Sumitomo Elec. U.S.A, Inc.* 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)).

Further, consider claims 4 and 5, which recite:

4. A method according to claim 1, further including the step of: d) receiving a message at the mobile terminal stating a value of the voucher.
5. A method according to claim 4, wherein step (d) includes the step of receiving a message stating the number of points in the respective user's account after addition of the value of the voucher.

The Examiner rejected claim 5 based on *Holda-Fleck's* statement "manufacturers are billed via logic circuit." (Examiner's Answer, page 4, citing Col. 5 26-32 of *Holda-Fleck*). The Examiner apparently considers the actor for step d of claim 5 to be "manufacturers." But, read in the context of the preamble, it is clear that step d refers to the "users" of the preamble "receiving" a message and not "manufacturers" "receiving" a message as suggested by the Examiner. Further, it is clear that read within the context of the preamble that the "user" of the preamble is the actor for each of steps a, b, and d, and that steps a and d do not have different actors. Clearly, the preamble limits the scope of the steps. For at least the above reasons, the preamble of claims 1 and 14-17 should be given patentable weight. (See M.P.E.P. 2111.02 I. "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." Citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.* 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)).

Further, without the preamble the purpose of the "voucher" may not be clear. But, when the steps of claim 1 are read within the context of the preamble then the purpose of the "voucher" is clear--the "users", are "receiving" vouchers and then "inputting" voucher codes to receive "points" which "are redeemable for rewards." For at least the above reasons, the preamble of claims 1 and 14-17 should be given patentable weight. (See for example M.P.E.P. 2111.02, summarizing *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003)(In considering the effect of the preamble in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the claims' recitation of a patient or a human "in need" gives life and meaning to the preamble's statement of purpose.)).

Additionally, the preamble of claim 28 should be given patentable weight. The preamble of claim 28 states:

"In a reward scheme in which users accumulate points in respective user accounts stored on a database, which points are redeemable for rewards, a method comprising:."

Thus, the preamble of claim 28 is modified from the preambles of claims 1, 14, 15, 16, and 17 to add "stored on a database" after "user accounts." Consider also the steps of claims 28:

- a) receiving from a mobile terminal a message containing a voucher code and an identifying code; and
- b) adding a points value derived from the voucher code to one of the user accounts selected according to the identifying code.

The preamble of claim 28 makes it clear that the actor of steps a and b is "receiving" a voucher code from the "users" of the preamble. Further, the preamble is the antecedent for "the user" in step b. Clearly then the preamble limits the scope of the claims. Further, the preamble makes it clear that the "points" of step b are "redeemable for rewards" as stated in the preamble. Therefore, the preamble of claim 28 should be given patentable weight. (See M.P.E.P. 2111.02 I., "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." Citing *Corning Glass Works v. Sumitomo Elec. U.S.A, Inc.* 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)).

Additionally, the Official Notice taken on page 4 of the Final Office Action should be withdrawn. The *Examiner's Answer* asserts on page 6 that the Appellants have not adequately traversed the Official Notice. Appellants disagree. The Examiner's Answer asserts on page 6 that the Appellants did not provide a "proper challenge that would at least cast reasonable doubt on the fact taken notice of." The Examiner Answer cites M.P.E.P. 2144.03 and *In re Boon*. The Appellants assert that the correct standard for whether or not Official Notice has been traversed is whether or not the Appellants specifically objected to the Office Notice. (See M.P.E.P. 2144.03 C., "A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate" and quoting *Chevenard* "[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). Appellants direct the Examiner's attention to Appellants specific traversal to the Office Notice during prosecution that "[t]o the extent that the Examiner has taken Official Notice of the use of points, and the use of points in a rewards scheme as recited in the claims, such Official Notice is traversed. The Examiner is requested to provide references showing such." Response to Final Office Action p. 11-12. The Examiner has not provided the requested references. Therefore, the Official Notice should be withdrawn.

With regards to the patentability of the rejected claims, Appellants respectfully refer to the arguments presented in the Appeal Brief filed October 3, 2007, in particular view of the preamble being given patentable weight and/or the Official Notice being withdrawn. For at least the above reasons, claims 1, 14-17 and 28 are patentable over *Holda-Fleck*. Claims 2-13 and 29-36 depend from claims 1 and 28, respectively, and therefore also recite patentable subject matter.

CONCLUSION

Appellants respectfully request reversal of the rejections of claims 1-17 and 28-36. These claims are allowable over the prior art. Appellants further request issuance of a Notice of Allowance.

Respectfully submitted,

Date: December 31, 2007

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